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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/667,266 | 09/19/2003 | Thomas Berndt | 2002P02639WOUS | 6023 |

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SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPT.
170 WOOD AVENUE SOUTH
ISELIN, NJ 08830

EXAMINER

ABRAMOWITZ, HOWARD E

| ART UNIT | PAPER NUMBER |
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1762

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/667,266

Applicant(s)

BERNDT ET AL.

Examiner

Howard E. Abramowitz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 7-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. attached
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

The preliminary amendment canceling claims 1-6 and providing new claims 7-22 has been received and entered.

Specification

The abstract of the disclosure is objected to because it is in the form of two paragraphs. Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities: (1) the cross reference provided by amendment at page 1 is objected to because it is disclosed as a US national stage of and international application, but was filed as a 37 C.F.R. 1.53(b) application; (2) and the claims should not be referred to in the specification and the term "claim 1" is used (page 1 line 4, page 2 lines 11 and 15) also claim 1 no longer exists as it was cancelled in the amendment.

Appropriate correction is required.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: claim 7 discloses "no binding agent is used to produce the mask layer" however; in the specification there is no mention of the benefit for not using a binding agent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15, 17, 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Fernihough et al. (US Patent Application Publication No. 2001/0048972).

Referring to claim 15, Fernihough et al. discloses (paragraph 26) a method for coating a surface comprising: applying a mask having a layer of ceramic powder to an uncoated area of the surface of the component; and coating of the component.

Referring to claim 17, Fernihough et al. discloses (paragraph 26) that the mask can be formed from a paste.

Referring to claim 19, Fernihough et al. discloses (paragraph 26) an aluminum layer can be applied to the component.

Referring to claim 20, Fernihough et al. discloses (paragraph 26) that the coating can be applied by a means of chemical vapor deposition.

Referring to claim 21, Fernihough et al. discloses (paragraph 2) that the component is part of a turbine.

Referring to claim 22, Fernihough et al. discloses (paragraph 2) that the part of the turbine is the turbine blade.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 7, 9-14, and 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Fernihough et al. as applied to claims 15, 17, 19-22 above, and further in view of Foster et al. (US Patent No. 4,726,104).

Referring to claims 7, 9, 11-14, Fernihough et al. teaches all the features of claim 7, 9, 11-14 (paragraph 2, paragraph 26) except, not using a binding agent to produce the mask layer.

However, Foster et al. discloses a masking agent that consists of a paste for use on turbine blades that is prepared without using a binding agent and has a viscosity in the range that readily adheres to metal surfaces (column 4 line 66 to column 5 line 10).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fernihough et al. to use a masking agent without a binder as suggested by Foster et al. with the expectation of the masking agent having the appropriate viscosity to bind well to a metal surface because Fernihough et al. teaches the benefit of using a ceramic powder as a mask and Foster et al. teaches that not using a binding agent produces a masking agent of the appropriate viscosity.

Referring to claims 10 and 18, Fernihough et al. does not disclose using a zirconium oxide powder for the masking agent.

However, Foster et al. teaches that zirconium oxide (from group ⁶IV_A of the periodic table) can be used as a masking agent because it can easily be completely removed from the surface (column 4 lines 29-38).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fernihough et al. to use a zirconium oxide masking agent as suggested by Foster et al. with an expectation that the mask will be easily removed after the coating process because Fernihough et al. teaches that a mask should be used to protect areas from being undesirably coated and Foster et al. teaches that the mask should be easily removable and made using zirconium oxide.

Claims 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fernihough et al. in view of Foster et al. as applied to claims 7, 9-14, and 18 above, and further in view of Rigney et al. (US Patent No. 6,521,294).

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Fernihough et al. in view of Foster et al. teaches to use a mask formed from ceramic powder it does not teach to use a suspension to form the mask.

However, Rigney et al. discloses (column 5 lines 21-22) that a slurry, synonymous with suspension, made of powder materials can be used to form the mask on a turbine blade (column 3 lines 25-35).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fernihough et al. in view of Foster et al. to use a suspension to form the mask as suggested by Rigney et al. with the expectation that the suspension will be easy to apply to the surface, because Fernihough et al. in view of Foster et al. teaches to use a mask formed of ceramic powder to coat the surface and Rigney et al. teaches that the powder for masks can be applied in the form of a suspension.

Claims 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fernihough et al. as applied to claims 15, 17, and 19-22 above, and further in view of Rigney et al. (US Patent No. 6,521,294).

Fernihough et al. teaches to use a mask formed from ceramic powder it does not teach to use a suspension to form the mask.

However, Rigney et al. discloses (column 5 lines 21-22) that a slurry, synonymous with suspension, made of powder materials can be used to form the mask on a turbine blade (column 3 lines 25-35).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fernihough et al. to use a suspension to form the mask as suggested by Rigney et al. with the expectation that the suspension will be easy to apply to the surface, because Fernihough et al. teaches to use a mask formed of ceramic powder to coat the surface and Rigney et al. teaches that the powder for masks can be applied in the form of a suspension.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 7, 8, 10-14, 15, 16, 18-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 7, 9, 11, 12, 37 and 38 of copending Application No. 10/820,483. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 7 of 10/820,483 teaches all the features of the independent claims, 7 and 15 of 10/667,266. While claims 7 and 15 of 10/667,266 do not mention, "masking

certain regions of the surface of the component” as stated in claim 7 of 10/820,483. It is implied that using a mask to protect an “area of the surface of the component”, as stated in claims 7 and 15 of 10/667,266, would be used to coat certain regions of the surface of the component.

The dependent claims 8, 10-14, 16 and 18-22 of 10/667,266 are also not patentably distinct from claims 1, 2, 7, 9, 11, 12, 37 and 38 of 10/820,483.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Howard E. Abramowitz whose telephone number is 571-272-8557. The examiner can normally be reached on monday-friday 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on 5712721423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


KATHERINE BAREFORD
PRIMARY EXAMINER